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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/275,887	03/25/1999	JOSEPH ROBERT OFFUTT JR.	043474/257035	1353
79901	7590	06/26/2009	EXAMINER	
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			ART UNIT	PAPER NUMBER
			3626	
			MAIL DATE	DELIVERY MODE
			06/26/2009	PAPER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOSEPH ROBERT OFFUTT, Jr. and JEROME EDWARD CASH

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Appeal 2009-001459  
Application 09/275,887  
Technology Center 3600

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Decided:<sup>1</sup> June 26, 2009

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*Before* HUBERT C. LORIN, ANTON W. FETTING, and  
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

Joseph Offutt, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 4-8, 10-13, 15-19, 21-24, 26-30, and 32-51. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.<sup>2</sup>

## THE INVENTION

The invention is a method, system and article for receiving requests from users reflecting travel itineraries and analyzing the itineraries to determine comparable itineraries based on associated rules. Specification 4:15-21. Then a value or cost of each itinerary is determined and a report generated. (Spec. 4:21-5:4).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for providing information regarding savings associated with travel alternatives comprising the steps, performed by a processor, of:
  - receiving a request from a user specifying a travel itinerary that includes a selected originating location and a selected destination location,
  - wherein the request includes information identifying the selected originating and destination

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Feb. 2, 2007) and Reply Brief ("Reply Br.," filed Jun. 22, 2007), and the Examiner's Answer ("Answer," mailed May 23, 2007).

locations, and proximity tolerances specifying a user's acceptable distance range of at least one of the selected originating location or selected destination location for searching for alternative itineraries;

analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request, wherein the analyzing step includes identifying at least one alternative itinerary including an alternate originating location or destination location that is within the proximity tolerances and different than the selected originating location or destination location of the travel itinerary specified in the request;

determining a value for the travel itinerary specified in the request; determining a value for of the alternative itineraries; and

generating a report, based on the analysis and determination, including a value for each alternative itinerary reflecting a savings in travel costs in comparison with the travel itinerary reflected by the request.

## THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Cochran	US 4,879,648	Nov. 7, 1989
Tagawa	US 5,732,398	Mar. 24, 1998
Walker	US 5,897,620	Apr. 27, 1999
DeLorme	US 5,948,040	Sep. 7, 1999

The following rejection is before us for review:

1. Claims 10 and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tagawa.
2. Claims 1, 2, 4, 12, 13, 15, 21, 23, 24, 26, 35, 36, 43-48, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tagawa and Cochran.
3. Claims 5-8, 16-19, 27-30, 49, and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tagawa, Cochran, and DeLorme.
4. Claims 11, 22, 33, 34, and 37-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tagawa and Walker.

#### ARGUMENTS

*The rejection of claims 10 and 32 under 35 U.S.C. § 102(b) as being anticipated by Tagawa.*

The Appellants traverse the Examiner rejection of claims 1 and 32 and argue that Tagawa does not describe a method including analyzing a travel itinerary, including a selected originating location or destination location, to determine a set of alternative itineraries different than the travel itinerary, that include an alternative origination location or destination location different than the selected origination location or destination location, as recited in claim 10 and a system having a server for performing the steps above. (App. Br. 16-17). The Appellants make two arguments against the Examiner's rejection.

First, the Appellants argue that, contrary to the Examiner's assertion in the Final Office Action, Tagawa's sub-routine that offers one or two choices different from a recommended choice is part of an option that

arranges lodging and not part of the option for purchasing airline tickets. (App. Br. 17). Therefore, the Appellants argue that Tagawa does not describe an option that includes both selecting an origin and destination and offering an alternative originating location or destination location that is different than the selected origin or destination as claimed. (App. Br. 19).

Second, the Appellants argue that Tagawa's description of a user selecting an out-of-state tour package including user selection of a destination and further refinement of the destination, cited by the Examiner, does not read on the limitations at issue. (App. Br. 19). The Appellants assert that a further refined destination does not correspond to an alternate destination; for example, a selected destination of Las Vegas is still the same destination as a further refined destination of the Las Vegas Strip. *Id.*

In the response, the Examiner again cites to Tagawa's description of a airline ticket purchase option at column 15, lines 25-50, the HELP button sub-routine of the local lodges option at column 13, lines 11-17, and the refined destination of the out of state tour packages routine at column 16, lines 55-60. (Ans. 21).

*The rejection of claims 1, 2, 4, 12, 13, 15, 21, 23, 24, 26, 35, 36, 43-48, and 50 under § 103(a) as being unpatentable over Tagawa and Cochran.*

The Appellants argue 1) that Tagawa and Cochran do not teach analyzing a travel itinerary, including a selected originating location or destination location, to determine a set of alternative itineraries different than the travel itinerary, that include an alternative origination location or destination location different than the selected origination location or destination location, 2) that Tagawa and Cochran do not teach receiving or

providing a request including proximity tolerances specifying a user's acceptable range for alternative itineraries or identifying an alternative itinerary that includes an alternative origination or destination location within the proximity tolerances, and 3) that Cochran is non-analogous art.

First, the Appellants again argue that Tagawa does not describe analyzing a travel itinerary, including a selected originating location or destination location, to determine a set of alternative itineraries different than the travel itinerary, that include an alternative origination location or destination location different than the selected origination location or destination location and, further, Cochran also does not describes this feature. (App. Br. 20-21).

The Examiner responds that Tagawa is relied upon for teaching these limitations since Tagawa describes a displaying a flight schedule with prices for a requested itinerary. (Ans. 21-22).

Second, the Appellant argues that Cochran does not teach providing a request including proximity tolerances specifying a user's acceptable range for alternative itineraries or identifying an alternative itinerary that includes an alternative origination or destination location within the proximity tolerances, as asserted in the rejection. (App. Br. 21). The Appellants argue that while Cochran discloses allowing a user to specify the proximity of a hotel/resort area of interest, Cochran does not disclose that the areas of interest are alternative hotel/resorts or otherwise correspond to alternative itineraries. *Id.*

The Examiner responds that in column 5, line 63 to column 6, line 7, Cochran describes a structured databases of hotel and resort information which can be search using qualifiers such as proximity to another location or

proximity to a specified area of interest such as a tourist attractions, business location or airports. (Ans. 22).

Third, the Appellants argue that Cochran is not pertinent to the claimed invention since the problem to which each are concerned are significantly different. (App. Br. 22-23). The Appellant asserts that Cochran is directed to overcoming drawbacks associated with searching through or making selections from an electronic database while the claimed invention is directed to locating non-obvious savings in the purchase of goods and services. (App. Br. 22).

The Examiner responds that although Cochran is not in the travel itinerary field, Cochran is clearly pertinent to the problem of proximity tolerances specifying a user's acceptable distance range. (Ans. 23-24).

*The rejection of claims 5-8, 16-19, 27-30, 49, and 51 under § 103(a) as being unpatentable over Tagawa, Cochran and DeLorme.*

The Appellants argue that claims dependent 5-8, 1-19, 27-30, 49 and 51 are patentable since neither Tagawa nor Cochran teaches the limitations of independent claims 1, 12, 23, and 50 at issue above. (App. Br. 23). The Appellants further argue that DeLorme does not teach the limitations at issue. (App. Br. 24).

*The rejection of claims 1, 22, 33, 34, and 37-42 under §103(a) as being unpatentable over Tagawa and Walker.*

The Appellants argue 1) that Tagawa and Walker do not teach analyzing a travel itinerary, including a selected originating location or destination location, to determine a set of alternative itineraries different



than the travel itinerary, that include an alternative origination location or destination location different than the selected origination location or destination location, 2) that Tagawa and Walker do not teach sending at least one price-to-beat request, where the price-to-beat request includes the values of the travel itinerary and alternative itineraries and receiving responses including a service provider travel itinerary that may be the same, or comparable, to the travel itinerary or an alternative itinerary, and 3) that Tagawa and Walker do not teach reconfiguring the values of the travel itinerary and the alternative itineraries based upon the responses from the service providers. (App. Br. 25-26).

First, the Appellants again argue that Tagawa does not describe analyzing a travel itinerary, including a selected originating location or destination location, to determine a set of alternative itineraries different than the travel itinerary, that include an alternative origination location or destination location different than the selected origination location or destination location and, further, Walker also does not describes this feature. (App. Br. 25).

Second, the Appellants argue that Walker describes a traveler submitting a bid to an airline for travel and does not teach sending at least one price-to-beat request, where the price-to-beat request includes the values of the travel itinerary and alternative itineraries, and receiving responses including a service provider travel itinerary that may be the same, or comparable, to the travel itinerary or an alternative itinerary and that Tawaga does not describe reconfiguring the values of the travel itinerary and the alternative itineraries based upon the responses from the service providers. (App. Br. 25).

The Examiner responds by citing column 6, lines 45-51 and stating that the bid of Walker is the claimed price-to-beat request. (Ans. 26).

## ISSUES

The issues are:

1. Does Tawaga describe a method including analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determining a value for the travel itinerary specified in the request?
2. Does Tawaga describe an apparatus having a server that is structured to analyze the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determine a value for the travel itinerary specified in the request?
3. Would one of ordinary skill in the art have been led by Tawaga and Cochran to a method including analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determining a value for the travel itinerary specified in the request?
4. Would one of ordinary skill in the art have been led by Tawaga and Cochran to an apparatus having a server that is structured to

analyze the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determine a value for the travel itinerary specified in the request?

5. Would one of ordinary skill in the art have been led by Tawaga and Cochran to a computer-readable medium having instructions that cause a computer analyze the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determine a value for the travel itinerary specified in the request?
6. Would one of ordinary skill in the art have been led by Tawaga, Cochran and DeLorme to a method including analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determining a value for the travel itinerary specified in the request?
7. Would one of ordinary skill in the art have been led by Tawaga, Cochran and DeLorme to an apparatus having a server that is structured to analyze the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel

itinerary specified in the request and determine a value for the travel itinerary specified in the request?

8. Would one of ordinary skill in the art have been led by Tawaga, and Walker to a method including analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determining a value for the travel itinerary specified in the request?
9. Would one of ordinary skill in the art have been led by Tawaga and Walker to an apparatus having a server that is structured to analyze the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determine a value for the travel itinerary specified in the request?
10. Would one of ordinary skill in the art have been led by Tawaga and Walker to a computer-readable medium having instructions that cause a computer analyze the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request and determine a value for the travel itinerary specified in the request?

## FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

### *Claim construction*

1. Claim 10 recites a method including the step of “analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request.”
2. Claim 10 recites “wherein the analyzing step includes identifying at least on alternative itinerary including an alternative originating location or destination location that is different than the selected originating location or destination location of the travel itinerary specified in the request.”
3. Claim 10 recites “determining a value for the travel itinerary specified in the request.”
4. Claims 1, 11, and 43 each recite methods including steps similar to the step of claim 10 above.
5. Claims 23, 30 and 32-34 each recite a system including a server that is structured for performing the steps recited in claim 10 above.
6. Claims 12, 21, 22, and 23 each recite a computer-readable medium containing instructions that cause a computer to perform the method steps of claim 10 recited above.

7. Claim 36 recites a system that includes:
  - a serving means for analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request, for determining a value for the travel itinerary specified in the request, for determining a value for each of the alternative itineraries, and for generating a report, based on the analysis and determination, including a value for each alternative itinerary reflecting a savings in travel costs in comparison with the travel itinerary reflected by the request.
8. The Specification describes a savings discovery server 400, which performs the steps shown Figure 6, which include the functions recited in claim 36. (Spec. 14:19 – 17:5 and Fig. 6).
9. Claim 44 recites a method including “receiving, from a user, a request specifying a travel itinerary that includes a selected origination location and a selected destination location, a first value associated with the itinerary.”
10. Claim 44 also recite “determining, without user intervention, a set of alternate itineraries different than the travel itinerary specified in the request.”
11. Claim 49 recites a method including the steps of claim 44 above.
12. Claim 50 recites a method including:
  - determining, without user intervention, a set of alternative itineraries different than the itinerary specified in the request, at least one alternative itinerary including an alternate route between an alternate origination location or alternate

destination location that is within the proximity tolerances, and either the origination or destination location of the travel itinerary specified in the request.

*The scope and content of the prior art*

Tawaga

13. Tawaga describes a method of selling travel related services or product through a self service system. (Col. 4, ll. 2-5).
14. Tawaga describes kiosks for self-service by users that are connected to regional reservation centers. (Col. 8, ll. 63-66).
15. Tawaga describes presenting a user with a basics options menu, which provides the user with eight options to choose from including local lodging, local or intrastate tour packages, airline tickets and out-of-state tour packages. (Col. 10, ll. 58-64 and Fig. 3).
16. Tawaga describes that if the user selects the “local lodging” option, the user is asked to provide a destination area, check-in and check-out dates, and hotel preferences. (Col. 12, ll. 31-53).
17. Tawaga describes the system searching a hotel inventory database and presenting the user with a recommended choice based on availability and a predetermined priority. (Col. 12, ll. 53-66).
18. Tawaga describes that if the user cannot make a decision on the recommended choice, the user can press a **HELP** button and one or two choices of hotels different from the first choice are offered. (Col. 13, ll. 11-17).

19. Tawaga describes that if the user selects the “local or intrastate tour packages” option, a menu listing the major packages for the market in which the kiosk is located is displayed. (Col. 14, ll. 16-21).
20. Tawaga describes the user being asked to select a one-day or multiple-day tour and to choose between a motor coach and self-guided tour, (Col. 14, ll. 25-34).
21. Tawaga describes that if the user chooses a multiple-day self-guided tour, the user will be asked if air transportation, lodging and a rental car should be included and if, air transportation is desired, then user will be asked to select the time of day for departure and return. (Col. 15, ll. 2-9).
22. Tawaga describes offering the user a recommended package based on the user’s input and a predetermined priority. (Col. 15, ll. 15-18).
23. Tawaga describes that if the recommended package is not accepted by the user and agent will intercede. (Col. 15, ll. 18-24).
24. Tawaga describes that if the user selects the “purchase airline ticket” option, the user is ask if they have an airline preference, origin, destination, date of travel, time of day for departure, and whether return in desired. (Col. 15, ll. 27).
25. Tawaga describes displaying a flight schedule of available flights with prices based on the user’s information for the user to select from. (Col. 15, ll. 41-44).



26. Tawaga describes that if the user selects the “out-of-state tour packages” option, a menu is displayed which allows the user to select a destination area. (Col. 16, ll. 41-44).
27. Tawaga describes that after a destination, such as Las Vegas, is selected the destination area can be further refined, such as Las Vegas strip, downtown Las Vegas, or properties off strip. (Col. 16, ll. 55-60).
28. Tawaga describes that the user is then asked for departure and return dates. (Col. 16, l. 67 – col. 17, l. 2).
29. Tawaga describes that tour packages with different options and prices are displayed. (Col. 17, ll. 5-8).
30. Tawaga then describes providing the user with a choice of hotels and asking for an airline preference and time of day for departure and return. (Col. 17, ll. 11-21).
31. Tawaga then describes asking the user to make a selection from a display of tour options with prices. (Col. 17, ll. 25-27).
32. Tawaga describes that if the user does not want to make a selection, the user can press the HELP button to be connected to a travel agent. (Col. 17, ll. 31-33).
33. Tawaga describes that after the user completes the screens for a chosen option, the kiosk returns to the welcome video and the  
Cochran
34. Cochran describes a method of allowing a user to select terms and using those terms to search through and obtains records in a database. (Col. 4, ll. 38-44).

35. Cochran, in Figure 4, depicts a specific working embodiment of Cochran's invention which searches a database of hotel and resort information. (Col. 5, ll. 61-64).
36. Cochran using geographic location of a property, proximity to another location, and proximity to specific areas of interest, such as tourist attractions as the terms. (Col. 5, l. 63 – col. 6, l. 5).

Walker

37. Walker describes a method of and system for selling airline tickets. (Col. 1, ll. 6-7).
38. Walker describes an embodiment where a traveler can submit a bid for a ticket which does not specify an actual flight number, departure time, or price. (Col. 6, ll. 33-48).
39. Walker describes the airline notifying the traveler via an interactive voice response unit or a live operator if the bid is accepted and selecting the actual flight. (Col. 6, ll. 64-67).
40. Walker describes notifying the traveler of the selected flight. (Col. 6, l. 1).

DeLorme

41. The Examiner cited DeLorme to teach using graphical coordinates with ranges to evaluate alternative routes. (Ans. 11).

*Any differences between the claimed subject matter and the prior art*

42. Tagawa does not describe analyzing a specified travel itinerary, including a selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified.

43. Tagawa does not describe determining a value for the specified travel itinerary.

*The level of skill in the art*

44. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of electronic commerce. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).
45. The Specification describes the field of invention as “electronic commerce, more particularly, to an apparatus and methods for determining non-obvious savings in the purchase of goods and services.” (Spec. 2:5-7).

*Secondary considerations*

46. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

## PRINCIPLES OF LAW

*Claim Construction*

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one

of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

*In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

#### *Anticipation*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

#### *Obviousness*

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art,

(2) any differences between the claimed subject matter and the prior art, and  
(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

#### ANALYSIS

*The rejection of claims 10 and 32 under 35 U.S.C. § 102(b) as being anticipated by Tagawa.*

##### *Method Claim 10*

We find that Tagawa does not anticipate claim 10 since Tagawa does not describe the recited method including the steps of analyzing the travel itinerary specified in the request, including the selected origination and destination locations, to determine alternate different itineraries and determining a value for the specified travel itinerary (FF 1-2).

The law of anticipation does not require that the reference “teach” what the subject patent teaches. Assuming that a reference is properly “prior art,” it is only necessary that the claims under attack, as construed by the court, “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or “fully met” by it.

*Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

In the rejection, the Examiner cites Tawaga's description of the "local or interstate tour packages" option as describing the claimed invention and equates the market, in which the kiosk exists, to an original location and the list of major tour packages to alternate destinations. (Ans. 19). The Examiner also cites to portions of Tagawa that describe the user's input to the "purchase airline ticket" option as including an origin and destination. (Ans. 19). However, we note that Tawaga describes the user's input of the "local or interstate tour packages" as a selection of a package destination. (FF 20).

We find that the "local or interstate tour package option" of Tawaga does not read on the claimed method. For the "local or interstate tour packages" option, Tagawa describes the system displaying a menu listing tour locations for the market in which the kiosk is located. (FF 19). From the user's selection of a tour location and other information inputted by the user (FF 19-23), the system in Tagawa displays a recommended tour and price, which the user can purchase, but from this mode, additional originating and destination locations are not further suggested. (FF 22). This does not read on the analyzing step of claim 10 or the step of determining a value for the specified travel itinerary.

Further, we note that the Examiner also cites to other portions of Tagawa that relate to the other options, such as the "local lodging" option, described in Tagawa. (Ans. 21). We find that Tagawa's description of these options (FF 1-18 and 24-30) also do not read on the claimed method.

Accordingly, we find that the Appellant have shown that the Examiner erred in rejecting claim 10, by failing to establish a prima facie showing of anticipation.

*Claim 32*

Claim 32 recites a computer system having a server that is structure for analyzing the specified itinerary and for determining the value of the specified itinerary as recited in the method of claim 10. (FF 5). For the same reasons as discusses above, we find that Tawaga does not describe a server that is structured to perform these function. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 32, by failing to establish a prima facie showing of anticipation.

*The rejection of claims 1, 2, 4, 12, 13, 15, 21, 23, 24, 26, 35, 36, 43-48, and 50 under § 103(a) as being unpatentable over Tagawa and Cochran.*

*Method Claims 1, 43, 44, and 50*

Claims 1 and 43 recite methods including similar steps as the steps at issue with regards to the rejection of claim 10. (FF 4). Claim 44 recites a method including a step that requires a first value associated with a specified itinerary and a step of determining a set of alternate itineraries. (FF 9-10). Claim 50 recites a step that requires determining a set of alternate itineraries. (FF 12).

Obviousness requires “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). “The first issue we address with respect to obviousness is the scope and content of the prior art—specifically whether the prior art

exhibited every step of the methods claimed in independent claims 1 and 31 of the '099 patent.” *Miniauction, Inc. v. Thomson Corp.*, F.3d (Fed. Cir. 2008).

In the rejection, the Examiner relied upon Tawaga and not Cochran for a teaching of these steps. (Ans. 3). As discussed above with regards to claim 10, we find that Tawaga does not teach these steps. Further, the Examiner did not articulate any further reasoning, with logical underpinnings, which would lead one of ordinary skill in the art to the invention as claimed. We find that one of ordinary skill in the art would not have been led by Tagawa and Cochran these steps. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claims 1, 43, 44, and 50 and claims 2, 4, and 45-48, dependent thereon, by failing to establish a prima facie showing of obviousness.

*Article Claims 12 and 21*

Claims 12 and 21 each recite a computer-readable medium containing instructions that cause a computer to perform a method including the analyzing and determining step of claim 10 at issue. (FF 6). For the same reasons as above with regards to claims 1 and 10, we find that one of ordinary skill in the art would not have been led by Tagawa and Cochran to a computer-readable medium as recited in claims 12 and 21. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claims 12 and 21 and claims 13 and 15, dependent thereon, by failing to establish a prima facie showing of obviousness.

*Apparatus Claim 23*

Claim 23 recites a computer system having a server that is structure for analyzing the specified itinerary and for determining the value of the



specified itinerary as recited in the method of claim 10. (FF 6). For the same reasons as above with regards to claims 1 and 10, we find that one of ordinary skill in the art would not have been led by Tagawa and Cochran to a server that is structured to perform as recited in claim 23. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 23 and claims 24, 26 and 35, dependent thereon, by failing to establish a prima facie showing of obviousness.

*Apparatus Claim 36*

Claim 36 recites an apparatus including a means-plus-function limitation. (FF 7).

Where a claim uses the word “means” to describe a limitation, we presume “that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses.” *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997) (citation omitted). This presumption can be rebutted where the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety. *Id.* at 1427-28, 44 USPQ2d at 1109. Once the court has concluded the claim limitation is a means-plus-function limitation, the court must first identify the function of the limitation. *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258, 52 USPQ2d 1258, 1263 (Fed. Cir. 1999). The court next ascertains the corresponding structure in the written description that is necessary to perform that function. *Id.* “Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.

*B. Braun Med. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997).” *Altiris Inc. v. Symantec Corp.* F.3d (Fed. Cir. 2003).

Claim 36 recites a serving means which performs the following functions:

analyzing the travel itinerary specified in the request, including the selected originating and destination locations, to determine a set of alternative itineraries different than the travel itinerary specified in the request, for determining a value for the travel itinerary specified in the request, for determining a value for each of the alternative itineraries, and for generating a report, based on the analysis and determination, including a value for each alternative itinerary reflecting a savings in travel costs in comparison with the travel itinerary reflected by the request.

We find that the savings discovery server 400 (FF 8) described in the Specification performs the functions above. (*See App. Br. 10-11*).

Therefore, we construe claim 36 to require a server which is structured to perform the functions above and its equivalent.

For the same reasons as above with regards to claim 1, we find that one of ordinary skill in the art would not have been led by Tagawa or Cochran to a serving means, as we have construed the limitation above. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 36 by failing to establish a *prima facie* showing of obviousness.

*The rejection of claims 5-8, 16-19, 27-30, 49, and 51 under § 103(a) as being unpatentable over Tagawa, Cochran and DeLorme.*

*Dependent claims 5-8, 16-19, 27-29 and 51*

These rejections are directed to claims dependent on claims 1, 12 and 23, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 5-8, 16-19, 27-29 and 51 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.").

*Method Claim 49*

Claim 49 recites a method including similar steps as the steps at issue with regards to the rejection of claim 10. (FF 11). In the rejection, the Examiner relied upon Tawaga and not Cochran or DeLorme for a teaching of these steps. (Ans. 13). As discussed above with regards to claims 1 and 10, we find that Tawaga does not teach these steps. Further, the Examiner did not articulate any other reasoning, with logical underpinnings, which would lead one of ordinary skill in the art to the invention as claimed. Therefore, we find that one of ordinary skill in the art would not have been led by Tagawa, Cochran and DeLorme to these steps. We find that the Appellants have shown that the Examiner erred in rejecting claim 49 by failing to establish a prima facie showing of obviousness.

*Apparatus Claim 30*

Claim 30 recites a computer system having a server that is structured for analyzing the specified itinerary and for determining the value of the specified itinerary as recited in the method of claim 10. (FF 5). In the rejection, the Examiner relied upon Tawaga and not Cochran or DeLorme

for a teaching of the server. (Ans. 13). For the same reasons as above with regards to claims 1 and 10, we find that one of ordinary skill in the art would not have been led by Tagawa, Cochran and DeLorme to a server that is structured to perform as recited in claim 30. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 30 by failing to establish a prima facie showing of obviousness.

*The rejection of claims 11, 22, 33, 34, and 37-42 under §103(a) as being unpatentable over Tagawa and Walker.*

*Method Claim 11*

Claim 11 recites a method including similar steps as the steps at issue with regards to the rejection of claim 10. (FF 4). In the rejection, the Examiner relied upon Tawaga and not Walker for a teaching of these steps. (Ans. 16). As discussed above with regards to claims 1 and 10, we find that Tawaga does not teach these steps. Further, the Examiner did not articulate any other reasoning, with logical underpinnings, which would lead one of ordinary skill in the art to the invention as claimed. Therefore, we find that one of ordinary skill in the art would not have been led by Tagawa and Walker to these steps. We find that the Appellants have shown that the Examiner erred in rejecting claim 11 and claims 37 and 38, dependent thereon, by failing to establish a prima facie showing of obviousness.

*Article Claim 22*

Claim 22 recites a computer-readable medium containing instructions that cause a computer to perform a method including the analyzing and determining step of claim 10 at issue. (FF 6). For the same reasons as above with regards to claims 1 and 10, we find that one of ordinary skill in

the art would not have been led by Tagawa and Cochran to a computer-readable medium as recited in claims 12 and 21. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 22 and claims 39 and 40, dependent thereon, by failing to establish a prima facie showing of obviousness.

*Apparatus Claims 33 and 34*

Claims 33 and 34 each recites a computer system having a server that is structured for analyzing the specified itinerary and for determining the value of the specified itinerary as recited in the method of claim 10. (FF 5). For the same reasons as above with regards to claims 1 and 10, we find that one of ordinary skill in the art would not have been led by Tagawa and Cochran to a server that is structured to perform as recited in claims 22 and 34. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claims 33 and 34 and claims 41 and 42, dependent thereon, by failing to establish a prima facie showing of obviousness.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting:

claims 10 and 32 under 35 U.S.C. §102(b) as being anticipated by Tagawa;

claims 1, 2, 4, 12, 13, 15, 21, 23, 24, 26, 35, 36, 43-48, and 50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tagawa and Cochran;

claims 5-8, 16-19, 27-30, 49, and 51 under 35 U.S.C. §103(a) as being unpatentable over Tagawa, Cochran, and DeLorme; and

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claims 11, 22, 33, 34, and 37-42 under 35 U.S.C. §103(a) as being unpatentable over Tagawa and Walker.

### DECISION

The decision of the Examiner to reject claims 1, 2, 4-8, 10-13, 15-19, 21-24, 26-30, and 32-51 is reversed.

### REVERSED

JRG

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